

### REMARKS

Reconsideration and allowance are respectfully requested.

Prior to entry of this amendment, claims 1–22 were pending in the application. By this amendment, claims 1, 3 and 6 have been amended, claim 2 has been cancelled and new claims 23 and 24 have been added. Applicant respectfully submits that no new matter is presented herein.

#### Claim rejections - 35 U.S.C. § 112

Claim 1 was rejected under 35 U.S.C. 112, second paragraph. In particular, according to the Examiner, the phrase “such as can be” renders the claim indefinite.

Claim 1 has been amended by deleting the phrase “such as can be”. Therefore, it is respectfully requested that this rejection be withdrawn.

#### Claim Rejections – 35 U.S.C. § 103

Claims 1-3 and 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Noecker.

Claim 1 has been amended by introducing the subject matter of original claim 2 and subject matter originally disclosed on page 11, lines 20-24, of the specification as filed, reciting: *“Advantageously, the single needle 34 is fashioned from a ferrous material with high resistivity and heated by causing an electric current to pass along it, so that an increase in temperature is brought about by the Joule effect.”*.

Amended claim 1 is new and inventive over Noecker. Noecker does not disclose or suggest that its needles 142 are heated by electric current passing along them. By contrast, Noecker teaches

heating a bar 167 by means of a heating coil 169 and transferring the heat from the bar 167 to the needles 142 by thermal conduction only, due to the sliding contact between the bar 167 and the needles 142. This is disclosed at col. 6, lines 19 to 41, and Figure 6 of Noecker. In particular, Figure 6 shows that the coil 169 heats the bar 167 and the heat passes to the needles 142, which slide into the bar 167.

Noecker therefore belongs to the known prior art acknowledged in the specification of the present application as filed, page 3, lines 9-13 reciting: *"Furthermore, the needles will be heated typically by thermal conduction, utilizing a heating element carrying electric current, which is positioned to engage each needle directly and supplied with power by way of sliding contacts"*.

Applicant does not see any teaching or suggestion in the cited art to modify the cigar piercing machine of Noecker in order to achieve the solution as claimed in present claim 1.

Furthermore, the Examiner does not provide any suggestion of the desirability of doing that which the present inventor has done (MPEP 706.02(j)). *"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."* Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In view of the above, amended claim 1 is believed to be in allowable condition.

Since claims 3-22 depend from claim 1, they are believed to be patentable for the same reasons as claim 1, as well as for the further limitations contained therein. In that regard, Applicant notes the Examiner's indication of allowable subject matter in claims 4-15 and 18-22.

New independent claims 23 and 24 have been introduced in the present set of claims.

New claim 23 comprises the subject matter of original claims 1, 2, 3 and 4.

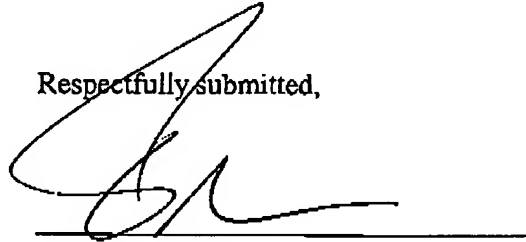
New claim 24 comprises the subject matter of original claims 1, 2 and 6.

In light of the Examiner's indication of allowable subject matter in claims 4 and 6, new independent claims 23 and 24 are believed to be in allowable condition.

### Conclusion

All matters being addressed above and in view of the pending claims and remarks, Applicant respectfully requests the entry of this Amendment, the Examiner reconsideration of the application, and the timely allowance of the pending claims. Applicant's counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this application.

Respectfully submitted,



Timothy J. Klima  
Reg. No.: 34,852

Harbin King & Klima  
500 Ninth Street SE  
Washington, DC 20003  
Ph: 202-543-6404  
Fax: 202-543-6406